

REMARKS

Claims 56, 69, 78, and 79 are pending in this application. Claims 56, 78, and 79 were rejected in the Final Office Action of July 18, 2008. Applicants note with thanks that claim 69 was allowed. Claims 56, 78, and 79 have been amended herein. Upon entry of this amendment, claims 56, 69, 78, and 79 will be pending in this application. The rejections are addressed individually below.

Claim 56 has been amended herein to recite the use of topical administration in the method. This amendment is supported by the specification, *inter alia*, at ¶¶ 47, 235, 243, 246, 248, and 259-262.

Claims 78 and 79 have been amended to delete the limitation “disease, disorder, or condition characterized by overproduction of melanin” and to instead recite “hyperpigmentation or brown spots.” These amendments are supported by the specification, *inter alia*, at ¶ 213.

The citations to the specification included throughout this response are to the paragraph numbers of the published application (US 2004/0175767).

I. Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 78 and 79 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement.

The Office Action states that “[t]he claims are drawn to methods comprising contacting melanocytes (claim 78) or skin (claim 79) with a claimed compound wherein the melanocyte or skin is in or is the skin ‘of a mammal having a disease, disorder, or condition *characterized by overproduction of melanin*’” (Office Action at page 3, emphasis in original). The Office Action asserts that “while Applicant has described methods of decreasing melanin content or decreasing skin pigmentation, he has not described the diseases, disorders, or conditions characterized by overproduction of melanin as presently claimed” (Office Action at page 4, emphasis in original). The Office Action further states that “two species of the claimed genus disclosed are within the

scope of the claimed genus, *i.e.* hyperpigmentation caused by inflammation or from diseases such as melasma, or brown spots such as ‘caf au lait’ macules” (Office Action at page 4).

Without acquiescing in the propriety of these rejections, and solely to expedite prosecution, claims 78 and 79 have been amended herein to delete the limitation “disease, disorder, or condition characterized by overproduction of melanin” and to instead recite “hyperpigmentation or brown spots.” These amendments are supported by the specification, *inter alia*, at ¶ 213. Therefore, amended claims 78 and 79 recite specific diseases, disorders, or conditions disclosed in the specification as filed.

Accordingly, Applicants respectfully submit that this rejection of claims 78 and 79 under 35 U.S.C. § 112, first paragraph has been overcome, and request that it be reconsidered and withdrawn.

II. **Rejection Under 35 U.S.C. § 102(b)**

Claim 56 was rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. 3,389,051 (“Kagan”).

Amended claim 56 recites “A method of decreasing melanin content in a melanocyte, the method comprising contacting the melanocyte via topical administration with an effective amount of one or more compounds selected from the group consisting of” compounds of formulae II-VIII.

The Office Action asserts that Kagan teaches oral administration or injection of compounds of formula VIII (Office Action at page 5, last paragraph), and that “oral administration or injection of a compound of Kagan will ‘contact’ a melanocyte as recited in claim 56” (Office Action at page 5, first paragraph). The Office Action further asserts that the method of Kagan “is considered to necessarily have the effect of decreasing melanin content in a melanocyte (claim 56) on the subject or cell being treated, whether expressly recognized by Kagan or not” (Office Action at page 7).

Without acquiescing in the propriety of the rejection, and solely to expedite prosecution, claim 56 has been amended herein so that the method requires the use of topical administration to

contact the melanocyte with the compound or compounds. This amendment is supported by the specification, *inter alia*, at ¶¶ 47, 235, 243, 246, 248, and 259-262. Therefore, amended claim 56 recites a method using topical administration of compounds of formulae II-VIII.

Kagan does **not** teach the topical administration of a compound of formula VIII whatsoever, let alone the topical administration of a compound of formula VIII in a method for decreasing melanin content in a melanocyte.

Accordingly, Applicants respectfully submit that this rejection of claim 56 under 35 U.S.C. § 102(b) has been overcome, and request that it be reconsidered and withdrawn.

III. Information Disclosure Statement

Applicants request that with the next Office Communication, the Examiner includes a signed copy of the Form 1449 that was filed with the Information Disclosure Statement on August 14, 2008.

IV. Conclusion

In view of the above amendments and arguments, Applicants believe the pending application is in condition for allowance.

Applicants hereby petition for a two month extension of time to file this response. Please charge the \$810.00 fee for the present Request for Continued Examination and the \$490.00 fee for the two month extension to our Deposit Account No. 08-0219. In the event other fees are due, please charge any underpayments or credit any overpayments to our Deposit Account No. 08-0219, under Order No. 0291472.00124US2, from which the undersigned is authorized to draw.

Respectfully submitted,

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